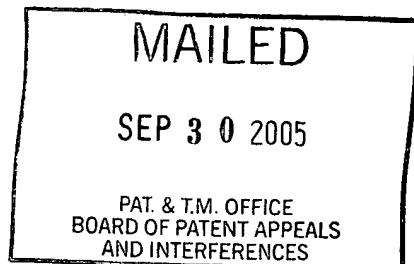




## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Fred E. McKelvey  
Telephone: (571) 272-9797  
Facsimile: (571) 273-0042



Applicants: Nolan et al.  
Application No.: 09/392869  
Filed: 09/09/99  
For: Catalyst complex with carbene  
ligand

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,373.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

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Fred E. McKelvey  
Senior Administrative Patent Judge

## INTERFERENCE DIGEST

Interference No. 105,373

Paper No.

Name: Steven P. Nolan et al.

Serial No.: 09/392,869

Patent No.

Title: Catalyst complex with carbene ligand

Filed: 09/09/99

Interference with Grubbs et al.

### DECISION ON MOTIONS

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

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### FINAL DECISION

Board of Patent Appeals and Interferences, \_\_\_\_\_ Dated, \_\_\_\_\_

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Court, \_\_\_\_\_ Dated, \_\_\_\_\_

### REMARKS

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This should be placed in each application or patent involved in interference in addition to the interference letters.

Mail Stop Interference  
P.O. Box 1450  
Alexandria Va 22313-1450  
Tel: 571-272-9797  
Fax: 571-273-0042

Paper 1

Filed 30 September 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Senior Administrative Patent Judge McKelvey)

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ROBERT H. GRUBBS and MATTHIAS SCHOLL,

Junior Party  
(Application 09/576,370),

v.

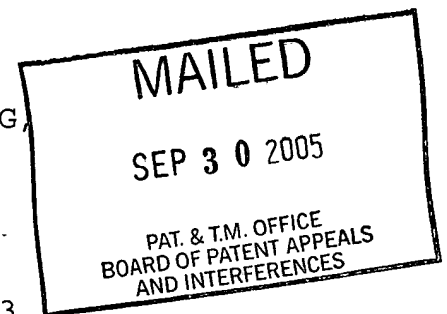
STEVEN P. NOLAN and JINKUN HUANG,

Senior Party  
(Application 09/392,869).

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Patent Interference No. 105,373  
Technology Center 1600

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**DECLARATION - Bd.R. 203(d)**

Before McKelvey, Senior Administrative Patent Judge.<sup>1</sup>

**Part A. Declaration of interference**

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the applications, count and claims designated as corresponding or as not corresponding to the counts appear in Parts E and F of this DECLARATION.

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<sup>1</sup> As part of Board efforts under the Government Paperwork Elimination Act, signatures on papers originating from the Board are being phased out in favor of a completely electronic record. Consequently, in this case papers originating at the Board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 C.F.R. § 10.18.

**Part B. Judge managing the interference**

Administrative Patent Judge McKelvey has been designated to manage the interference. 37 CFR § 41.104(a) [Bd. R. 104(a)].

**Part C. Standing order**

A Trial Section STANDING ORDER (Paper 2) accompanies this DECLARATION. The STANDING ORDER applies to this interference.

**Part D. Initial conference call**

A telephone conference call to discuss the interference is set for 1:30 p.m. (1330 hours) on Wednesday, 30 November 2005 (the Board will initiate the call).

No later than **two business days (i.e., Monday, 28 November 2005)** prior to the conference call, each party shall file and serve by facsimile (STANDING ORDER ¶ 4.5) a list of the motions (Bd. R. 120; Bd. R. 204; STANDING ORDER ¶ 26) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

**Part E. Identification and order of the parties**

Junior Party

Named inventors: Robert H. Grubbs, South Pasadena, CA  
Matthias Scholl, Pasadena, CA

Application: Application 09/576,370,  
filed 22 May 2000

Title: Imidazolidine-based metal carbene  
metathesis catalysts

Assignee: California Institute of Technology

Accorded Benefit: Provisional application 60/142,853,  
filed 07 July 1999<sup>2</sup>

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<sup>2</sup> It is noted that Grubbs claims priority of provisional application 60/135,493, filed 24 May 1999. To the extent Grubbs believes it is entitled to benefit for the purpose of priority of the provisional application, a motion for benefit may be listed in the motions list.

Senior Party

Named Inventors: Steven P. Nolan, New Orleans, LA  
Jinkun Huang, New Orleans, La

Application: 09/392,869  
filed 09 September 1999

Title: Catalyst complex with carbene ligand

Assignee: University of New Orleans Foundation

Accorded Benefit: Provisional application 60/115,358,  
filed 08 January 1999

None<sup>3</sup>

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<sup>3</sup> It is noted that Nolan claims priority of provisional application 60/099,722 filed 10 September 1998. To the extent Nolan believes it is entitled to benefit for the purpose of priority of the provisional application, a motion for benefit may be listed in the motions list.

The senior party is assigned exhibit numbers 1001-1999.  
Bd. R. 154(c)(1).

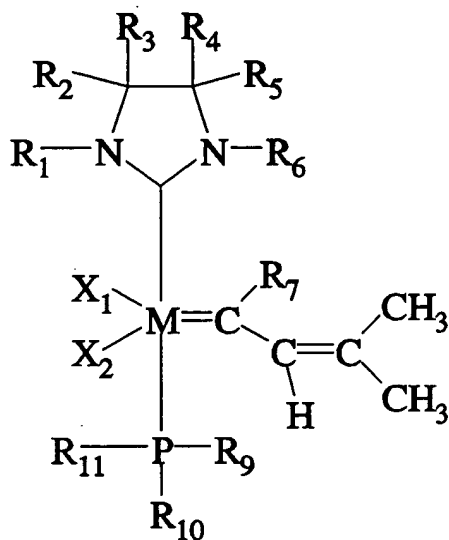
The junior party is assigned exhibit numbers 2001-2999.  
Bd. R. 154(c)(1).

The senior party is responsible for initiating settlement discussions. STANDING ORDER ¶ 18.

Part F. Counts and claims of the parties

Count 1

A composition of matter having the formula:



where:

- M is osmium (Os) or ruthenium (Ru);
- P is phosphorous
- R<sub>1</sub> is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R<sub>2</sub> is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R<sub>3</sub> is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R<sub>4</sub> is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R<sub>5</sub> is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;
- R<sub>6</sub> is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;



- R<sub>7</sub> is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl but cannot be -C=C-YZ, where Y and Z are any moiety;
- R<sub>9</sub> is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- R<sub>10</sub> is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- R<sub>11</sub> is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;
- X<sub>1</sub> is an anionic ligand; and
- X<sub>2</sub> is an anionic ligand.

**NOTE: There is no R<sub>8</sub>.**

The claims of the parties are:

Grubbs: 1-64

Nolan: 9, 11-14, 17-21, 23-40, 43-65, 71-73 and 77-111

The claims of the parties which correspond to Count 1 are:

Grubbs: 1-39 and 41-64

Nolan: 9, 11-14, 17-21, 23-40, 45-46, 51-62, 71, 73, 77-78, 89-92 and 107-109

The claims of the parties which do not correspond to Count 1 are:

Grubbs: 40

Nolan: 43-44, 47-50, 63-65, 72, 79-88, 93-106 and 110-111

**Part G. Heading to be used on papers**

The heading in STANDING ORDER Form 1 must be used on all papers filed in this interference. See STANDING ORDER ¶ 7.2.1. The administrative patent judge and parties must be indicated as follows:

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Senior Administrative Patent Judge McKelvey)

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ROBERT H. GRUBBS and MATTHIAS SCHOLL,

Junior Party  
(Application 09/576,370),

v.

STEVEN P. NOLAN and JINKUN HUANG,

Senior Party  
(Application 09/392,869).

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Patent Interference No. 105,373  
Technology Center 1600

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**Part H. Order form for requesting file copies**

When requesting copies of files, use of STANDING ORDER Form 4 will greatly expedite processing of the request. Please attach a copy of Part E of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

**Part I. Required paragraph for affidavits and declarations**

The Board has recently experienced a rash of cases in which a witness has belatedly advanced reasons why he or she would be unable to appear for cross examination at a reasonable time and place in the United States. Consequently, the Board is requiring the following paragraph to be included on the signature page of all affidavits (including declarations) filed in this case to prevent surprise and hardship to the party relying on the testimony of the witness:

In signing this affidavit/declaration, I recognize that the affidavit/declaration will be filed as evidence in a contested case before the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I also recognize that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.

Enc (there is no Form PTO-850):

STANDING ORDER (Paper 2)  
Claims Nolan application 09/392,869  
Bibliographic data Nolan application 09/392,869  
Power of attorney application 09/392,869  
Specification, as filed for Nolan application 09/392,869  
Nolan provisional application 60/099,722  
Original claims application 09/392,869  
Nolan provisional application 60/115,358  
Grubbs provisional application 60/142,835  
Grubbs specification application 09/576,370  
Grubbs original claims application 09/576,370  
Grubbs drawings application 09/576,370  
Amendment adding claim application 10/576,370  
Stevens, "Polymer Chemistry," pages 285-289 (1990)  
Collman, "Principles and Applications of  
Organotransition Metal Chemistry," pages 591-592

Revised January 2005

cc (via overnight delivery):

Attorney for Grubbs  
(real party in interest  
California Institute of Technology):

Reed Intellectual Property Law Group  
1400 Page Mill Road  
Palo Alto, CA 94304-1124

Tel: 650-251-7000  
Fax: 650-251-7739  
Email: reed@reedpatent.com

Attorney for Nolan  
(real party in interest  
University of New Orleans Foundation):

TOWNSEND AND TOWNSEND AND CREW, LLP  
Two Embarcadero Center  
8th Floor  
San Francisco, CA 94111-3834

Tel: 415-576-0200  
Fax: 415-576-0300  
Email: None

Attorney for the United States [28 CFR § 0.45(f)]:

Hon. John Fargo, Director  
Commercial Litigation  
Civil Division  
U.S. Department of Justice  
1100 L Street, N.W.  
Room 11116  
Washington, D.C. 20530

Tel: 202-514-7223  
Fax: 202-307-0345